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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
|-----------------|-------------|----------------------|---------------------|------------------|

10/579,982

05/19/2006

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07-2123

3593

20306

7590

07/21/2010

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EXAMINER

TREYGER, ILYA Y

ART UNIT

PAPER NUMBER

3761

MAIL DATE

DELIVERY MODE

07/21/2010

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**(6) Grounds of Rejection to be Reviewed on Appeal**



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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/579,982  
Filing Date: May 19, 2006  
Appellant(s): LARSSON, MICHAEL

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Kirsten L. Thomson  
For Appellant

**EXAMINER'S ANSWER**

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This is in response to the appeal brief filed 04/16/2010 appealing from the Office action mailed 09/16/2009.

**(1) Real Party in Interest**

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The following is a list of claims that are rejected and pending in the application:

1-11 and 14-16.

**(4) Status of Amendments After Final**

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

**(5) Summary of Claimed Subject Matter**

The examiner has no comment on the summary of claimed subject matter contained in the brief.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except

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for the grounds of rejection (if any) listed under the subheading “WITHDRAWN REJECTIONS.” New grounds of rejection (if any) are provided under the subheading “NEW GROUNDS OF REJECTION.”

### **WITHDRAWN REJECTIONS**

The following grounds of rejection are not presented for review on appeal because they have been withdrawn by the examiner. The rejection of claims 11 and 14-16 under 35 U.S.C. 103(a) has been withdrawn.

### **(7) Claims Appendix**

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant’s brief.

### **(8) Evidence Relied Upon**

|           |          |        |
|-----------|----------|--------|
| 4,536,180 | Johnson  | 8-1985 |
| 7,025,718 | Williams | 4-2006 |

### **(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson (US 4,536,180) in view of Williams (US 7,025,718).

4. In Re claims 1-3,6, 9 and 10, Johnson discloses a surgical suction instrument comprising:  
a catheter (Fig. 1) having a suction passage 16 (Fig. 1), which is a drainage lumen (Col. 4, line 4) having a proximal end 12 (Fig. 1) in fluid communication with a venting passage 18 (Fig. 1), which is an auxiliary lumen (Col. 4, line 6);

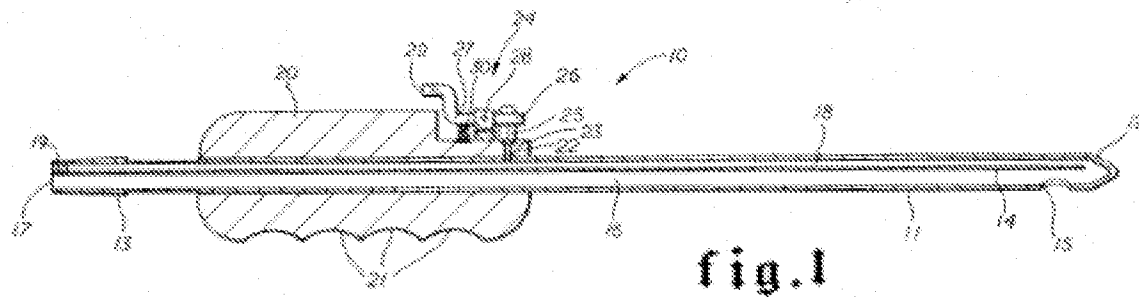
the surgical instrument is disclosed for use of body material suction (Abstract, line 1) that reads on the collection container is present;

a source of suction (Col. 4, lines 29-31);

a valve apparatus 24 (Fig. 1) for opening the auxiliary lumen (Col. 4, lines 13, 14); and

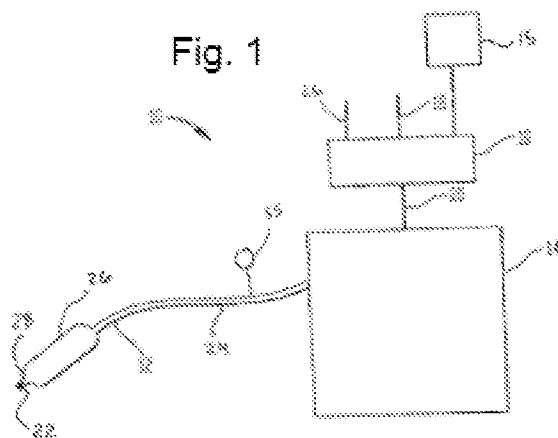
since the source of vacuum is disclosed as being controllable (Col. 4, lines 30, 31), the controller for controlling pressure difference between a pressure in the drainage lumen and a pressure in the atmosphere is provided.

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Johnson does not expressly disclose the apparatus comprising a pressure sensor for measuring the pressure in the lumen.

Williams teaches the catheter device (Abstract, lines 1-2) that is a pump system (claim 2) (Col. 5, lines 22-24) comprising a pressure sensor 55 (Col. 6, lines 26-28; Fig. 1) for measuring the pressure in the lumen 24 (Col. 5, line 42; Fig. 1) (claim 6) in communication with the programmable control logic module 16 (claim 3) (Col. 6, lines 34-39; Fig. 1), wherein, due to its programmable nature, the control logic module is fully capable of increasing the pressure continuously or/and abruptly (claims 9 and 10) and fully capable to open the lumen only when the pressure measured in the lumen corresponds to atmospheric pressure.



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It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the apparatus of Johnson with the controlled pump system, as taught by Williams in order to employ the conventionally known way for measuring the pressure in the lumen.

In addition, the claim would have been obvious because the technique for improving a particular class of devices was part of the ordinary capabilities of a person of ordinary skill in the art, in view of the teaching of the technique for improvement in other situations.

5. In Re claim 4, Johnson discloses the invention discussed above, but does not expressly disclose the vent valve being operated automatically via controller.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the vent valve operable automatically via the controller, since it has been held that broadly providing a mechanical or automatic means to replace manual activity which has accomplished the same result involves only routine skill in the art.

6. In Re claim 5, Johnson discloses the surgical instrument (catheter) fully capable of increasing the negative pressure to achieve any pressure level allowed by the vacuum source (Col. 4, lines 29-31).

7. In Re claims 6-8, Johnson discloses the invention discussed above but does not expressly disclose the apparatus comprising two sensors for measuring the pressure in the lumen.

Williams teaches the catheter device (Abstract, lines 1-2) comprising a pressure sensors 22 (Col. 5, lines 49-50; Fig. 1) and 55 (Col. 6, lines 26-28; Fig. 1) for measuring the pressure in

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the lumen 24 (Col. 5, line 42; Fig. 1) (claim 6) in communication with the programmable control logic module 16 (claim 3) (Col. 6, lines 34-39; Fig. 1).

The rationale of obviousness rejection discussed above in claim 1 is incorporated herein in its entirety.

Johnson in view of Williams do not expressly disclose two sensors measuring the pressure in the different lumens.

As set forth in **MPEP 2144.04 (VI-B)**, since the second sensor measuring the pressure in the different lumen does not produce any unexpected result, it would have been obvious to one having ordinary skill in the art at the time the invention was made to position the second sensor in the different lumen in order to improve control over the pressure in both lumens, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art (See: *In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1960)).

#### ***Allowable Claimns***

8. Claims 10 and 14-16 are allowed.

The following is an examiner's statement of reasons for allowance: The Prior Art of record US 4,536,180 and US 7,025,718 fail to teach or suggest the step of "increasing the pressure difference between a pressure in the drainage lumen and a pressure in the atmosphere only when the pressure measured in the auxiliary lumen corresponds at least to atmospheric pressure, wherein the pressure difference is increased by increasing the power of the source of suction".



**(10) Response to Argument**

9. With respect to claim 1, Appellant argues that the combination of references is improper because the apparatus of Williams has not been designed to remove fluid or tissue from the body but is drawn to a very different purpose.

In response to applicant's argument that the reference of Williams is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, since both Johnson and Williams belong to catheters, and Williams belongs to the same problem solving area as that claimed by the Appellant, i.e. maintaining the pressure in the lumen, the combination of references is deemed to be proper.

10. With respect to claims 11 and 14-16, Appellant's arguments are moot in view of withdrawn of the rejection of claims.

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Ilya Y Treyger/

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